

17m AF



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF FOR THE APPELLANTS

Ex parte Harri Korpela, *et al.*

FORMING A COMMUNICATION NETWORK

Serial No. 10/028,950
Appeal No.: Not yet assigned
Group Art Unit: 2619

In the event that there may be any further fees due with respect to the filing of this paper, please charge Deposit Account No. 50-2222.

A handwritten signature in black ink that reads "Peter Flanagan".

Peter Flanagan
Attorney for Appellants
Reg. No. 58,178

SQUIRE, SANDERS & DEMPSEY LLP
8000 Towers Crescent Drive, 14th Floor
Tysons Corner, VA 22182-2700

Atty. Docket: 059643.00139

PCF/mmi:cqc:dlh

Encl.: Reply Brief



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Appellants:

Confirmation No.: 5366

Harri Korpela, *et al.*

Appeal No.: Not yet assigned

Serial Number: 10/028,950

Group Art Unit: 2619

Filed: December 18, 2001

Examiner: Steven H. D. Nguyen

For: FORMING A COMMUNICATION NETWORK

REPLY BRIEF

May 5, 2008

I. INTRODUCTION

This is an appeal from the final rejection set forth in an Office Action dated September 4, 2007, (“the Office Action”) finally rejecting claims 21-47, all of the claims pending in this application, as being unpatentable. A Notice of Appeal and Pre-Appeal Brief Request for Review were timely filed on November 1, 2007. A Notice of Panel Decision was mailed December 7, 2007, permitting the appeal to continue. An Appeal Brief was timely submitted on January 7, 2008. On March 5, 2008, an Examiner’s Answer was mailed, which – while it slightly changed at least one ground of rejection – generally maintained the rejections of the claims. This Reply Brief is being provided in supplement to the Appeal Brief, which already sets forth a full and complete basis for reversing the erroneous rejections of the claims. It is hoped that this Reply Brief will serve to highlight some of the errors in the original rejection, and address the new ground of rejection. The rejections being erroneous, it is respectfully requested that the rejections be reversed.

II. SUMMARY OF EXAMINER'S ANSWER

At sections 1-8 and 11, the Examiner's Answer generally favorably indicated compliance of the Appeal Brief and did not add any additional information. However, with respect to item 5, the Examiner's Answer stated that there was one area with respect to which the Appeal Brief was allegedly deficient.

At section 9, the Examiner's Answer largely repeated sections 2-6 of the Office Action. In section (9)(2), however, the Examiner's Answer provided a somewhat new ground of rejection, in that the Examiner inserted the phrase "a network model tool" (including the quotation marks) into the rejection.

At section 10, the Examiner's Answer provided some responses to certain of the arguments set forth in the Appeal Brief.

III. RESPONSE TO SECTION (5)

At item (5), the Examiner's Answer asserted that the summary of claimed subject matter contained in the brief is deficient. The Examiner's answer, states the deficiency is alleged, cites the appropriate rule, and then provides the following justification for the statement that the section is deficient: "The brief is deficient because the specification does not state an arrangement being a network model [sic] stool [sic] as stated in page 8, lines 1-5 and page 8, line 20 to page 9, line 1." (citations are to lines in the Appeal Brief, as best understood) There is no immediately apparent connection between this alleged deficiency and the regulatory requirements of 37 CFR 41.37(c)(1)(v), provided by the Examiner.

Appellants acknowledge that the specification does not expressly state, "the term 'network modeling tool' is equivalent to the term 'arrangement'." The discussion of "arrangement" within the context of the written description portion of the application, however, provides clear and unequivocal support for the recitation of "network modeling tool" that is presented in, for example, claims 30 and 39.

Indeed, it is respectfully submitted that the allegation of deficiency here is just an improper attempt by the Examiner to argue the "possession" rejection under 35 U.S.C. 112, first paragraph, which alleges that the specification does not provide evidence of possession of the presently claimed invention. The "possession" rejection is fully addressed in the Appeal Brief at page 11-15. Furthermore, there is additional rebuttal discussion on that topic provided in section (V) of this Reply Brief.

IV. RESPONSE TO SECTION (9)

Appellants respectfully note that ground of rejection presented at Section (9) of the Office Action has been changed. The rejection now includes the phrase “a network model tool” (including the quotation marks) in the rejection of claims 30-47 under 35 U.S.C. 112, first paragraph. This is a new ground of rejection. Nevertheless, even the new ground of rejection is erroneous, as will be discussed at greater length in Section (V) of this Reply Brief.

V. RESPONSE TO SECTION (10)

From pages 5-7, the Examiner's Answer contained various responses to arguments, as Section (10) of the Examiner's Answer. The Appeal Brief is capable of standing on its own, and provides a sufficient, un rebutted basis upon which the rejections should be reversed. Nevertheless, for the convenience of the Honorable Board, some additional comments, particularly addressing the somewhat new ground of rejection are provided below.

Possession Rejection Issues

Claims 30-47 were improperly rejected under 35 U.S.C. 112, first paragraph, as allegedly not possessed by Appellants in the originally filed application. Appellants' thoroughly rebutted this rejection as previously presented, and continue to urge that the rejection is erroneous and should be reversed.

In Section (10), the first paragraph (lines 2-8, of page 5 of the Examiner's Answer) characterizes Appellants' arguments. Appellants respectfully decline to accept the characterizations of Appellants' arguments. Appellants' own characterization of Appellants' arguments is more clear and understandable than the itemized list of arguments provided in the Examiner's Answer.

For example, Appellants had argued at the paragraph bridging pages 11-12 of the Appeal Brief, that the "possession" rejection was clearly erroneous because it was directed to "software tool" (which is not recited in the claims) rather than to what was claimed,

“network modeling tool.” The new ground of rejection inserts the phrase “network modeling tool” (including the quotation marks) after the phrase “software tool” (without quotation marks) in the rejection, at page 3 (next to last line) of the Examiner’s Answer (compare page 3, next to last line of item 3, of the Office Action, which omits “network modeling tool”).

This change in the rejection still has the problem that the Examiner’s Answer is asserting “software tool” against the claims, whereas the term “software tool” is not found in the claims. Oddly, the paragraph beginning “With respect to (1),” in the Examiner’s Answer at page 5, continues to argue against the recitation “software tool,” which was not presented.

With respect to “network modeling tool,” however, since this feature is recited in the claims, an understanding of the remaining arguments in rebuttal of the rejection should be noted.

In the first full paragraph at page 12 of the Appeal Brief, the Appellants explained that possession for the recitation “network modeling tool” was supported by the original specification as filed. In response, at the end of the paragraph beginning “With respect to (1),” in the Examiner’s Answer at page 5, the Examiner asserts that “The specification only discloses a manual process to perform the claimed invention by using an arrangement or method.” This faulty assertion was already fully addressed and rebutted in the Appeal Brief, especially at the last two lines of page 13, and the first two paragraphs on page 14.

In the paragraph beginning with “With respect to (2),” at page 5 of the Examiner’s Answer, the Examiner stated disagreement with the view of arrangement as a general purpose computer programmed to execute software modules or an application specific integrated circuit. The Examiner’s basis for disagreeing was “the applicant does not provide any fact such as prior art or paper, to indicate that one of ordinary skill in the art understands that an arrangement is software or program product as stated by the applicant.” This reason for disagreement is both rationally and legally insufficient.

It is important to recognize that the duty of establishing lack of possession is on the Examiner, not *vice versa*. Furthermore, the Examiner does not dispute the fact that one of ordinary skill in the art would appreciate that “arrangement” is a broad term that would encompass, for example, a general purpose computer programmed to execute software modules or an application specific integrated circuit (ASIC). Since the Examiner does not dispute this, it is not really incumbent on Appellants to provide evidence of something that is not in dispute. The Examiner cannot disagree with Appellants simply because Appellants have not provided evidence for something so readily apparent as that the word “arrangement” has broad meaning.

Nevertheless, Appellants note that standard dictionaries, such as Merriam-Webster On-line Dictionary, 10th edition, provide very broad definitions for the term “arrangement,” such as “something made by arranging parts or things together <a floral arrangement>.” Such a definition is broad enough to encompass a general purpose

computer, a software program, and/or an ASIC. Thus, if it were required, recourse to a normal dictionary definition of the term would be sufficient to establish that the term has very broad meaning.

The Examiner (who has the burden of proof) has not provided any definition of “arrangement” at all, and has not actually disputed the position Appellants have taken, as the only basis for the Examiner’s disagreement was the Appellants have not provided evidence. Thus, the record does not provide any legally recognizable basis to uphold the Examiner’s rejection for alleged lack of possession.

The Examiner continued, in the paragraph bridging pages 5-6 of the Examiner’s Answer, by arguing that the Examiner disagrees with the position that “the invention is not a manual process,” stating – as the basis for disagreement – “the specification does not disclose a software or program product to perform the functions of the claims.” The words “software” and “program product” are not found in the original specification. However, the term “arrangement” is found in the original specification, a fact that the Examiner does not dispute. The Examiner also does not dispute that the Appellants need not use the same terminology in the claims as in the original specification. Furthermore, Appellants have already demonstrated (at pages 12-15 of the Appeal Brief) that the arrangement is not just a manual process.

The Examiner continued in the same paragraph, by stating “However, no single manual work to handle both the process and expansion of a network.” This sentence

fragment was already rebutted in the Appeal Brief at page 14, middle paragraph.

The Examiner continued in the same paragraph, by stating “It clearly does not disclose a software network model tool to implement the functions of the claims” As an initial point, it should again be pointed out that “network modeling tool” not “software network model tool” is what is recited. Thus, the rationale is not directed to what is claimed, and is irrelevant.

Furthermore, the support given by the Examiner’s Answer for the conclusion that “It clearly does not disclose ...” is faulty. The support provided is, “because the applicant does not provide any fact such as prior art or paper, to indicate that one of ordinary skill in the art understand that an arrangement is a software or program product as stated by the applicant.” As noted above, neither “software” nor “program product” as such is recited in the claims, and consequently this rationale is not relevant to what is claimed. Furthermore, this reason for concluding lack of possession is erroneous, because the Examiner does not dispute that “arrangement” would convey such concepts to one of ordinary skill in the art of network modeling.

Furthermore, as noted above, the burden is on the Examiner to show that arrangement would **not** convey such concepts to one of ordinary skill in the art, not on Appellants to demonstrate that it would. The Examiner has provided no fact, such as prior art document or white paper that would indicate that the term “arrangement” would be narrowly understood to mean only a manual process. Thus, the record cannot support the

rejection, and the rejection must be reversed.

Indefiniteness Rejection Issues

Claims 21-47 were improperly rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. Beginning at page 15, the Appeal Brief demonstrated that the indefiniteness rejection was clearly improper, as the rejection was based on a criticism of the claim terms as broad, not insoluably ambiguous.

At page 6, in the paragraph beginning, “With respect to (4),” the Examiner’s answer continued to argue that the claims are too broad, as best understood. Some sentences, because of syntactical/grammatical problems were not readily understandable, such as, “The claims which contain ‘technical solutions’ are the undue breadth claims because the term is too broad.” As best understood, this is simply an acknowledgment that the rejection is really founded on the wrong legal basis, as the Examiner seems to have agreed that a broad claim is not an indefinite claim (“In reply, the examiner agrees with the applicant that a breadth claim which contains a broad term is not indefinite or vague.”). Since Appellants have invented a broad invention, they are entitled to a patent with broad claims, and the fact that the claims are broad is not a legitimate reason for rejection.

The Examiner’s Answer continued by stating (in the same paragraph), “For example, what is it mean for technical solution such hardware, software etc.” As best understood, this sentence is intended as a question. The answer to the question is that “technical solutions” is a broad categorical term that is not limited to particular hardware

or software. Nevertheless, the application provides some examples of technical solutions, as can be seen, for example, from the Figures of the present application. In any event, no *prima facie* case of indefiniteness has been presented, and consequently the rejection should be reversed.

Finally, the paragraph concluded by an assertion that essentially seemed to say that metes and bounds of the invention could not be determined because the claims are too broad. Appellants respectfully disagree. As noted above and in the Appeal Brief, “too broad” is not the legal standard of indefiniteness. The fact that Appellants have used very broad terminology to describe a portion of the invention is simply good claim draftsmanship. One of ordinary skill in the art would be fully apprised by the claim terminology of the broad scope of protection asserted by the claims with respect to the feature “technical solutions,” and would attribute to that term the meaning set forth at pages 15-16 of the Appeal Brief, a meaning that the Examiner does not challenge in any way, shape, or form. Thus, the rejection should be withdrawn as improper.

Statutory Subject Matter Issues

Claims 21-47 were improperly rejected under 35 U.S.C. 101, as allegedly being directed to non-statutory subject matter. At pages 16-19, Appellants rebutted the rejections that had been for alleged lack of statutory subject matter. Among Appellants’ arguments was a comparison of the presently pending claims to the claims addressed in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998), in

which providing a result to a user was deemed sufficient to qualify the claimed subject matter as statutory.

The Examiner, at page 6, in the paragraph beginning “With respect to (5),” argued that “providing a comparison of different technical solutions to a user based on the modeling is not similar to provide [sic] a share value to a user.” The very limited explanation for this alleged dissimilarity is expressed in two sentences in the Examiner’s Answer.

First, the Examiner stated, “Since, a step of providing a comparison of different technical solutions to a user based on the modeling is not a final price which calculates by physical or the steps o process because it give a user the different between the technical solutions in order to allow a user to select a best technical solution.” (all errors in original)

This sentence makes little sense, and Appellants are unable fully to determine what the Examiner means to say.

The Examiner is right that the comparison of solutions is not a “final price,” because it is not a price at all. However, this is dissimilarity that is not of any particular significance.

Although the output is not a “final price” the output is information that is useful to the user.

Just as a financial advisory could use the “final price” in the *State Street* case, even so the user of the present application can use the “comparison of technical solutions” in the present case. The important similarities are that the outputs in both cases (*State Street* and the present case) are informational results that are meaningful and useful to the users of the

systems.

Furthermore, the Examiner stated, “Therefore, the claim is not statutory because providing a comparison of different technical solutions to a user is not a final result.” The assertion, “providing a comparison of different technical solutions to a user is not a final result” is plainly wrong. It is the final result of the method of claim 21, for example. The fact that such a result can be put to further use just demonstrates the utility of the result. Indeed, the same could be said of the “price” in the *State Street* case. That “price” is helpful to financial advisors in that it could be put to further use. Thus, again, the similarities that matter swamp the dissimilarities between the cases.

VI. MANY UNANSWERED ARGUMENTS

The Examiner's Answer left many arguments unanswered. For example, on page 18, Appellants demonstrated that the rejection for lack of statutory subject matter was clearly erroneous with respect to the claims for a "tool," because the alleged judicial exception asserted in the Office Action was not applicable to machine inventions, such as a "network modeling tool."

Likewise, in the rebuttal to the rejection for alleged lack of possession, the Appeal Brief had demonstrated support from various portions of the specification, and the Examiner's Answer failed to address those portions of the specification, such as page 1, lines 28-30, of the specification.

In each case, the arguments that were not answered by the Examiner's Answer should be taken as admitted, and form independent and alternative grounds upon which the rejection should be reversed as clearly improper.

IX. CONCLUSION

For the reasons set forth above, it is respectfully submitted that each of claims 21-47 recites subject matter that clearly meets the requirements of 35 U.S.C. 101 and 112. This final rejection being in error, therefore, it is respectfully requested that this honorable Board of Patent Appeals and Interferences reverse the Examiner's decision in this case and indicate the allowability of application claims 21-47.

The Appeal Brief previously submitted provided a full and complete rebuttal of the rejections originally presented, and this Reply Brief is merely in supplement thereto. Thus, the failure of Appellants to repeat any arguments here, should not be considered a waiver of any of those arguments.

In the event that this paper is not being timely filed, Appellants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees which may be due with respect to this paper may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

SQUIRE, SANDERS & DEMPSEY LLP

A handwritten signature in black ink, appearing to read "Peter Flanagan", written in a cursive style.

Peter Flanagan
Attorney for Appellants
Registration No. 58,178

Atty. Docket No.: 059643.00139
8000 Towers Crescent Drive, 14th Floor
Tysons Corner, VA 22182-2700
Tel: (703) 720-7800
Fax (703) 720-7802
PCF/mmi:cqc:dlh